

Remarks

The examiner issued a number of objections under 37 C.F.R. 1.75 and rejections under 35 U.S.C. § 112. Claims 1-173 have been canceled and claims 174-228 have been added. The new claims reflect changes in line with the examiner's suggestions. Claims 174-175 correspond with claims 141 and 142, which were rejected in the previous office action only under 35 U.S.C. § 112, second paragraph. All of the claims are believed to be in allowable form for the following reasons.

Double Patenting

The examiner provisionally rejected a number of claims for double patenting over claims 1-12 of copending application Serial No. 10/811,090, which was expressly abandoned on June 27, 2005. Applicant respectfully requests that the provisional double patenting rejections be withdrawn.

Rejection of claims 112, 124, and 139-140 as anticipated

In order to establish a case of *prima facie* anticipation, the examiner must establish that a prior art reference discloses every limitation of the claims either explicitly or inherently. *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed. Cir. 1999). The examiner has not met this burden with respect to claims 174-218.

-Wang

The examiner rejected claims 112, 124, and 139-140 as anticipated under 35 U.S.C. 102(b) by Wang.

-Response

Claims 176, 199, and 209 specify that "R² is selected from the group consisting of alkyl groups having from about 1 to 6 carbon atoms and aryl groups." Claim 186 specifies that "R² is selected from the group consisting of t-butyl groups, isopropyl groups, and secondary butyl groups." The examiner has not pointed to a teaching compounds having the claimed R² in Wang.

Applicant respectfully requests that the rejection over Wang be withdrawn.

Claims 1.

-Wan

The examiner rejected claims 112, 124, and 139-140 as anticipated under 35 U.S.C. 102(b) by Wan. Claims 112-173 have been cancelled.

-Response

Once again, claims 176, 199, and 209 specify that "R² is selected from the group consisting of alkyl groups having from about 1 to 6 carbon atoms and aryl groups." Claims 186 specifies that "R² is selected from the group consisting of t-butyl groups, isopropyl groups, and secondary butyl groups." The examiner has not pointed to a teaching of a compound having the claimed R² in Wan.

Applicant respectfully requests that the rejection over Wan be withdrawn.

-Kiyoshi

The examiner rejected claims 112, 124, and 139-140 as anticipated under 35 U.S.C. 102(a) by Kiyoshi (JP-08-157597).

-Response

The compound in Kiyoshi is somewhat ambiguous, since the cited portion of Kiyoshi actually reads "1 and 4-screw (4-amino benzoyloxy)-2- chlorobenzene." (Emphasis added). Based on the remainder of the compound name and the examiner's interpretation, the compound appears to describe a "chloro" substituent rather than Applicant's R², "selected from the group consisting of alkyl groups having from about 1 to 6 carbon atoms and aryl groups" (claims 176 and 199) or "selected from the group consisting of t-butyl groups, isopropyl groups, and secondary butyl groups" (claim 186).

The examiner therefore has not pointed to each and every element of the pending claims in Kiyoshi. Applicant respectfully requests that the rejection of the claims over Kiyoshi be withdrawn.

-Kim

The examiner rejected claims 112, 118-119, 124, 130-131, and 139-140 as anticipated over Kim. Kim is said to teach "1,4-bis (4-amino benzoyloxy)-2-phenyl benzene compound."

-Response

Claim 176 specifies that, "when both X and Y are amino group, one or more of X or Y further consists essentially of spacer group." Claim 176 further specifies that spacer group is "selected from the group consisting of H-(CH₂)_n-O- groups, Cl(CH₂)_n-O- groups, Br(CH₂)_n-O- groups, I(CH₂)_n-O-, wherein n is from about 2 to about 12 wherein the CH₂ groups independently are optionally substituted by oxygen, sulfur, or an ester group; provided that at least 2 carbon atoms separate said oxygen or said ester group."

Claim 199 also specifies such spacer group. The examiner has not pointed to a teaching of the claimed features in Kim.

Claim 186 specifies that " R^2 is selected from the group consisting of t-butyl groups, isopropyl groups, and secondary butyl groups." The examiner has not pointed to a teaching of compounds having the claimed R^2 in Kim.

Claim 199 specifies that "X is polymerizable group comprising polymerizable unsaturated carbon-carbon bond." The examiner has not pointed to a teaching of the foregoing in Kim.

Applicant respectfully requests that the rejection of the claims over Kim be withdrawn.

-Aharoni and Meyer

The examiner rejected claims 112, 118-119, 124, 130-131, and 139-140 as anticipated over Aharoni and over Meyer.

-Response

Claim 176 specifies that

when both X and Y have amino group, one or more of X or Y further consists essentially of spacer group selected from the group consisting of $H-(CH_2)_n-O-$ groups, $Cl(CH_2)_n-O-$ groups, $Br(CH_2)_n-O-$ groups, $I(CH_2)_n-O-$, wherein n is from about 2 to about 12 wherein the CH_2 groups independently are optionally substituted by oxygen, sulfur, or an ester group; provided that at least 2 carbon atoms separate said oxygen or said ester group.

Claim 209 includes similar specifics regarding spacer group(s). The examiner has not pointed to the foregoing in Aharoni.

Claim 186 has been amended to specify that " R^2 is selected from the group consisting of t-butyl groups, isopropyl groups, and secondary butyl groups." The examiner has not pointed to compounds having the claimed R^2 in Aharoni or in Meyer.

Claim 199 specifies that "X is polymerizable group comprising polymerizable unsaturated carbon-carbon bond." and that "Y comprises amino group." The examiner has not pointed to a teaching of the foregoing combination of X and Y in Aharoni or in Meyer.

Applicant respectfully requests that the rejection of the claims over Aharoni and/or Meyer be withdrawn.

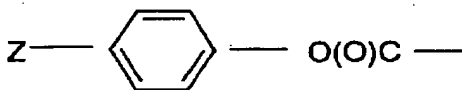
-Wellinghoff references, Norling, and Rawls

The examiner rejects claims 139, 143, 147, and 149 as anticipated by : Wellinghoff (WO 98/13008); Wellinghoff et al (J. Den. Res. 1997, p. 279 (abstract 2127), vol. 76); Norling (American Association for Dental Research meeting, April 2000); and Rawls (ACS polymer preprints, 9/1997, p. 167-168, vol. 38(2).

-Response

Claim 176 specifies that "when either X or Y is polymerizable group, the other of X or Y is amino group." Claim 186 includes a similar limitation. The examiner has not pointed to this limitation in any of the two Wellinghoff references, Norling, or Rawls.

Claim 199 specifies that one or more member selected from the group consisting of X and Y has the following structure:



The examiner has not pointed to a teaching or suggestion of this limitation in any of the two Wellinghoff references, Norling, or Rawls.

Applicant respectfully request that the rejection over the two Wellinghoff references, Norling, and Rawls, be withdrawn.

-Bigg

The examiner rejects claims 139-140 as anticipated over Bigg.

-Response

Claims 176 and 199 specify that "R² is selected from the group consisting of alkyl groups having from about 1 to 6 carbon atoms and aryl groups." Claim 186 specifies that "R² is selected from the group consisting of t-butyl groups, isopropyl groups, and secondary butyl groups." The examiner has not pointed to a teaching of compounds having the claimed R² in Bigg. The claims also include other features which distinguish Bigg.

Non-obviousness

The examiner did not issue an alternate obviousness rejection over the cited references. In order to establish that the claims are *prima facie* obvious over the cited references, the examiner must point to two things in the references, and not in the applicant's disclosure--(1) the suggestion of the invention, and (2) the expectation of its success. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). See also MPEP 2143. The examiner has not met this burden for all of the reasons discussed above.

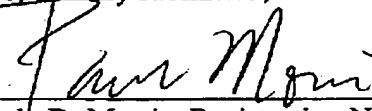
The examiner cannot establish *prima facie* obviousness by merely arguing that a cited reference could be derived by modifying that reference to incorporate something not taught or suggested by the reference, itself, or by another cited reference. In order to establish *prima facie* obviousness, the examiner has the burden to point to a teaching or suggestion in the references themselves that it would be desirable to make such a

modification. MPEP 2143.01; *In re Brouwer*, 37 U.S.P.Q.2d 1663, 1666 (Fed. Cir. 1995). The examiner has not met this burden.

CONCLUSION

For all of the foregoing reasons, Applicant respectfully requests consideration and allowance of claims 174-228.

Respectfully submitted,



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